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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/546,134	08/24/2006	Ulrich Haerer	3926.203	9905
30448	7590	11/02/2007		
AKERMAN SENTERFITT P.O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER WILSON, LEE D	
			ART UNIT 3723	PAPER NUMBER
			MAIL DATE 11/02/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/546,134

Applicant(s)

HAERER ET AL.

Examiner

LEE D. WILSON

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 8/24/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. Claims 4-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**a. The following claims are vague, indefinite, confusingly and awkwardly worded:**

- i. "and/or" in claim 4. The limitations cannot be claimed in both the alternative and inclusively.
- ii. "or" in claim 5. The limitations cannot be claimed in the alternative because it will not be clear which limitation has be relied upon for patentability.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimm et al (5095662).

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- b. Grimm et al discloses a process as claimed in claims 1-6. Grimm et al discloses a process having a hone stone (col.2,line 4) with a cone (fig.1, element 18), and adjusting honing parameters (col.2, lines 5-21).
  - c. In regard to the workpiece being of different hardness/softness and length from 20 to 200 mm of introduction of the cone in axial direction and change in radius of inner surface for 10 to 100 micro meters.
  - d. Grimm et al discloses the claim of the workpiece being of different hardness/softness and length from 20 to 200 mm of introduction of the cone in axial direction and change in radius of inner surface for 10 to 100 micro meters would have been obvious to one having ordinary skill in the art because based on the variety of workpieces the claimed invention would be used in such a predictable manner to produce the predictable results of the above ranges because of obvious experimentation and use determined by market demands of different workpiece construction.
4. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delle Vedrove (5613894) in view of Grimm et al (5095662).
- e. Delle Vedrove discloses a process as claimed in claims 1-7. Delle Vedrove discloses a process having a hone (first and second (117,20)) with a cone (figs.5a-5c), and adjusting honing parameters (17,18,32).
  - f. Grimm et al discloses that stone honing were known in the prior art and one skilled in the art could have combined the stone with the honing tool of Delle Vedrove with no change in their respective functions and the

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combination would yielded predictable results to one having ordinary skill in the art at the time of the invention.

g. In regard to the workpiece being of different hardness/softness and length from 20 to 200 mm of introduction of the cone in axial direction and change in radius of inner surface for 10 to 100 micro meters.

h. The modified Delle Vedrove discloses the claim of the workpiece being of different hardness/softness and length from 20 to 200 mm of introduction of the cone in axial direction and change in radius of inner surface for 10 to 100 micro meters would have been obvious to one having ordinary skill in the art because based on the variety of workpieces the claimed invention would be used in such a predictable manner to produce the predictable results of the above ranges because of obvious experimentation and use determined by market demands of different workpiece construction.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The 892 form discloses prior art being made of record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE D. WILSON whose telephone number is 571-272-4499. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH HAIL can be reached on 571-272-4485. The

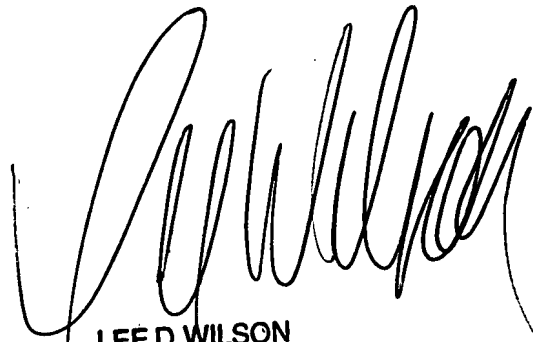
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fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ldw

October 26, 2007



LEE D. WILSON  
PRIMARY EXAMINER